



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/543,150

07/25/2005

Susumu Saisho

274417US0PCT

2650

22850

7590

06/11/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

ZIMMERMAN, JOHN J

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

06/11/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/543,150	<b>Applicant(s)</b> SAISHO ET AL.	
	<b>Examiner</b> John J. Zimmerman	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20071026</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## SECOND OFFICE ACTION

### *Amendments*

1. This Second Office Action is in response to the correspondence titled "AMENDMENT AND REQUEST FOR RECONSIDERATION" received February 25, 2008. Claims 1-17 are pending in this application.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syslak (WO 02/090031).

4. Syslak discloses that an aluminum multilayer brazing sheet can be made having an inner aluminum alloy cladding layer comprising 0.7-1.5 wt.% Mn, 0-1.2 wt.% Si, 0-0.6 wt.% Fe, 1.0-2.0 wt.% Zn, 0.5 wt.% Mg and 0-0.5 wt.% Ti (e.g. see page 5, lines 22-26). In addition, Syslak

Art Unit: 1794

discloses that the core material is an aluminum alloy comprising 0.7-1.5 wt.% Mn, 0-0.6 wt.% Si, 0-0.6 wt.% Fe, 0-0.6 wt.% Zn, 0-1.0 wt.% Cu, 0-0.4 wt.% Mg and 0-0.5 wt.% Ti (e.g. see page 5, lines 6-13). The brazing alloy layer can comprise 4-14 wt.% Si, 0-0.8 wt.% Fe, 0-0.5 wt.% Cu, 0-0.5 wt.% Mg, 0-0.5 wt.% Mn, 0.1-2 wt.% Zn and 0-0.5 wt.% Ti (e.g. see page 5, lines 1-5) is clad on one or both sides of multilayer sheet (e.g. see page 3, lines 5-15). Higher Zn content in the cladding layer renders the cladding layer less noble than the core layer (e.g. see page 6, lines 9-19). The braze layer can be arranged on one side of the core and the inner cladding layer can be arranged on the other side of the core (e.g. see claim 4). Although the alloying constituent ranges for the layers of Syslak may not have the same endpoints as the ranges described in the rejected claims, the ranges do overlap. Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549. See MPEP 2144.05. While it is noted that the compositions in the claims may use the term "consisting essentially of", this term allows for additional alloying constituents which do not affect the basic and novel characteristics of the invention, *Ex parte Davis, et al.*, 80 USPQ 448 (PTO Bd. App. 1948); *In re Janakirama-Rao*, 137 USPQ 893 (CCPA 1963). There is no factual evidence of record that the additional constituents of Syslak affect the basic and novel characteristics of the invention and therefore they are not prohibited by the "consisting essentially" claim language. See MPEP 2111.03.

***Response to Arguments***

5. Applicant's arguments filed February 25, 2008 have been fully considered but they are not persuasive with regards to the remaining rejection.

6. The rejection under 35 U.S.C. 103(a) as being unpatentable over Yamada (U.S. Patent Application Publication No. 2002/0037426 A1), has been withdrawn in view of applicant's amendments to the claims. One of ordinary skill in the art would not have motivation to omit the additional layers of Yamada in order to meet the "consisting" language of the pending claims.

7. Regarding the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over Syslak (WO 02/090031), applicant argues applicant uses "consisting essentially of" language and that Syslak contains further additional alloying constituents. The examiner notes, however, that the term "consisting essentially of" allows for additional alloying constituents which do not affect the basic and novel characteristics of the invention, *Ex parte Davis, et al.*, 80 USPQ 448 (PTO Bd. App. 1948); *In re Janakirama-Rao*, 137 USPQ 893 (CCPA 1963). When applicants contend that modifying components in the prior art compositions are excluded by the recitation of "consisting essentially of", applicants have the burden of showing that the basic and novel characteristics of their composition are materially affected by those components, *In re De Lajarte*, 143 USPQ 256 (CCPA 1964). It is not clear where applicant has shown that the additional constituents of Syslak affect the basic and novel characteristics of the invention. As noted in MPEP 2111.03, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel

characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” In any event, where additional alloying elements are disclosed by Syslak to be optional or less than a maximum, those constituents can be zero.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John J. Zimmerman  
Primary Examiner  
Art Unit 1794

/John J. Zimmerman/  
Primary Examiner, Art Unit 1794

jjz  
June 5, 2008